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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,316	05/26/2000	Pierre Girard	100954-001	9687
23117	7590	04/19/2006	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/508,316	GIRARD ET AL.	

Examiner	Art Unit	
Lawrence D. Ferguson	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 February 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 3-6 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed February 2, 2006.

Claims 1 and 3-6 were amended and claims 2 and 7-8 were cancelled rendering claims 1 and 3-6 pending.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1 and 3-6, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al. (U.S. 6,465,086).

Kitamura teaches an ink jet recording material having two coatings, where the inner coat comprises silica (column 2, lines 23-31 and column 8, lines 19-30) and where the first and second coatings are formed on the surface (column 3, lines 17-65, column 6, lines 10-42 and column 7, lines 49-60). Kitamura discloses the coating layer can be formed by conventional coating means, including a gravure means (column 12, lines 22-26 and column 22, lines 20-22) where the support is a paper sheet (column 13, lines 41-50). Kitamura discloses the inner coat (underrecording layer) comprises silica and the surface coat (upperrecording layer) comprising kaolin or calcium carbonate (column 8,

lines 21-30). Kitamura further discloses the invention being of conventional coated paper sheets (column 8, lines 5-18 and column 20, line 22) where paper sheets conventionally comprise fibrous materials. The reference discloses drying the coated paper (column 13, lines 20-33 and column 25, lines 20-27) and calendering the material (column 25, lines 28-32). Kitamura does not explicitly disclose that the cited inner coat has the deposition amount as instantly claimed. Such deposition amount is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the deposition amount, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. deposition amount) fails to render claims patentable in the absence of unexpected results. The aforementioned limitation is optimizable as it directly affects the mechanical strength and durability of the coated paper. As such, it is optimizable. It would have been obvious to one of ordinary skill in the art to make the coated paper with the limitations of the deposition amount of the inner coat since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

Response to Arguments

4. Applicant's arguments regarding rejection made under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al. (U.S. 6,465,086) have been considered but are unpersuasive. Applicant argues the composition of the inner coat includes a single

pigment of silica and the conventional surface coat consists of kaolin and/or calcium carbonate as a pigment, which excludes silica as a pigment in such a coat.

Kitamura discloses the inner coat (underrecording layer) comprises silica and the surface coat (upperrecording layer) comprising kaolin or calcium carbonate (column 8, lines 21-30). Kitamura discloses the coating layer can be formed by conventional coating means, including a gravure means (column 12, lines 22-26 and column 22, lines 20-22) where the support is a paper sheet (column 13, lines 41-50). Applicant argues since Kitamura is directed to coating for ink jet printing, such a conventional coating must necessarily contain silica. Examiner maintains that Kitamura does not disclose that the surface coat (upperrecording layer) must necessarily contain silica. Additionally, every coating that utilizes ink jet printing does not contain silica.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


L. Ferguson
Patent Examiner
AU 1774


RENA DYE
SUPERVISORY PATENT EXAMINER
A.U. 1774 4/17/04